No. 85-1057

Supreme Court, U.S.
FILED
JAN 27 1986
JOSEPH F. SPANIOL, JR.
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1985

OTARI CORPORATION,

Petitioner,

v.

KING INSTRUMENT CORPORATION,

Respondent.

OTARI BRIEF IN REPLY TO KING INSTRUMENT OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ALLEN KIRPATRICK III
Attorney for Otari
Suite 1100
1615 L Street,N.W.
Washington, D.C. 20036
(202) 861-3500

Of Counsel

WILLIAM T. BULLINGER
C. MICHAEL ZIMMERMAN
PAUL E. WHITE, JR.
CUSHMAN, DARBY & CUSHMAN
Suite 1100
1615 L Street, N.W.
Washington, D.C. 20036
(202) 861-3000

PRESS OF BYRON S. ADAMS, WASHINGTON, D.C. (202) 347-8203

IN THE

Supreme Court of the United States

OCTOBER TERM, 1985

No. 85-1057

OTARI CORPORATION,

Petitioner,

v.

KING INSTRUMENT CORPORATION,

Respondent.

OTARI BRIEF IN REPLY TO KING INSTRUMENT OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Rule 22.5 of this Court permits this reply brief addressed to arguments first raised in the respondent's opposition brief.

The new argument raised by respondent King is that the district court made a finding of equivalency. King wants that new argument believed to support its further argument that the court of appeals simply found the finding to be not clearly erroneous.

The truth is that the district court never made any finding of equivalency. The court of appeals itself

noted as much, *see* its statement, "(not specifically made here)" in its opinion, *see* at p. A-31 of Appendix to Otari's petition (same at p. A17 of King's Appendix).

The argument made by King to the court of appeals was entirely different from the one now made. The earlier argument was to the effect that *there was no need* to find equivalency. In its second brief (filed January 14, 1985) King argued at p. 31 that:

> "The finding of direct and literal reading of the '153 claims on the Otari equipment establishes direct infringement—*completely refuting the need to employ equivalents. Atlas Powder Co. v DuPont de Nemours & Co.*, App. No. 84-504, Slip Op. at 23 (Fed Cir. Dec 27, 1984). (See Supp. Addm. 39).
>
> Otari argues that 'the claims at issue are "means plus function" claims, requiring findings of equivalency between the accused machines and what is described in the '153 application. (sic)' Otari cites neither claims nor claim language in support of its point.[*] *No evidence was presented at trial on the issue,* Otari declining to cross-examine King's expert Zimmerman (JX908-912)."
> (Emphasis supplied, except for original emphasis for citation.)

In point of fact, King had taken the same position in the district court. The latter, in error, adopted it, and made no finding of equivalency.

---

*Otari had cited claims and claim language (at p. 40 of a brief filed December 3, 1984) and King was completely wrong in this statement.

It is notable that in King's new argument it avoids reference to its earlier admission that it *offered no evidence on the issue of equivalency* at trial in the district court.

Accordingly, the positions taken by Otari in its petition are sound. What the court of appeals did was to undertake a study of the record in a program of itself making a finding of fact of equivalency—and in so doing it placed a burden of proving non-equivalency on Otari. All this was error. The action by this Court requested in the petition should be granted.

Respectfully,

ALLEN KIRKPATRICK III
ATTORNEY FOR OTARI
Suite 1100
1615 L Street, N.W.
Washington, D.C. 20036
(202) 861-3500

OF COUNSEL

WILLIAM T. BULLINGER
C. MICHAEL ZIMMERMAN
PAUL E. WHITE, JR.
CUSHMAN, DARBY & CUSHMAN
Suite 1100
1615 L Street, N.W.
Washington, D.C. 20036
(202) 861-3000

Dated January 24, 1986

SERVICE

Three copies of this reply brief have been served on counsel of record for King Instrument Corp. by first class mail, postage prepaid, this 24th day of January, 1986, addressed as follows:

Harold C. Hohbach
FLEHR, HOHBACH, TEST,
ALBRITTON & HERBERT
Suite 3400
Four Embarcadero Center
San Francisco, CA 94111

ALLEN KIRKPATRICK III